

By the present amendment, Claims 1-7 have been cancelled. Claims 8-17 have been added.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

The Examiner reflected claims 1-3 and 7 under U.S.C. §102(b) as anticipated by and claim 4 under 35 U.S.C. §103(a) as being unpatentable over Possati U.S. Patent No. 5,299,360 (Possati). It is respectfully submitted that claims 8-17 are patentable over Possati, Claims 1-7 having been cancelled.

Specifically, claim 8 recited that the diameter of the break-off region remains substantially unchanged.

As explained in the specification, providing a stylus with a break point having a changed structure of the stem material but with the diameter of the break-off region substantially unchanged noticeably increases the flexural strength of the stylus. This is not disclosed in Possati.

On the contrary, Possati explicitly discloses that the break-off region has a reduced diameter (a thinner section) (column 4, lines 16-18). A reduced diameter break-off region (14) is clearly shown in Fig. 1.

A rejection based on 35 U.S.C. §102 as in the present case, requires that the cited reference disclose each and every element covered by the claim.

Electro Medical Systems S.A. v. Cooper Life Sciences, 32 U.S.P.Q. 2d 1017, 1019 (Fed. Cir. 1994); Lewmar Marine Inc. v. Barient Inc., 3 U.S.P.Q. 2d 1766-68 (Fed. Cir. 1987); Verdegaal Bros., Inc. v. Union Oil Co., 2 U.S.P.Q. 2D 1051, 1053 (Fed. Cir. 1987). The federal Circuit has mandated that 35 U.S.C. § 102 requires no less than “complete anticipation . . . [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, 35 U.S.P.Q. 2d at 1019; Verdegaal Bros., 2 U.S.P.Q. 2d at 1053.

Since Possati fails to disclose each and every feature of independent claim 8, Possati, as a matter of law, does not anticipate the present invention, as defined by said independent claim.

In view of the above, it is respectfully submitted that Possati does not anticipate or make obvious the present invention as defined in claim 8, and the present invention is patentable over Milne.

Claims 9-12 depend on claim 8 and are allowable for the same reasons claim 8 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in claim 8 are not disclosed or suggested in the prior art.

Claims 13-17 are directed to a coordinate-measuring machine with a stylus of claims 8-12 and are allowable for the same reasons claims 8-12 are allowable.

### **CONCLUSION**

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is

respectfully requested that such amendment or correction out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully Submitted  
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail and addressed to: Commissioner for Patents, Washington, DC 20231 on February 24, 2003.

✓  
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